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REMARKS

Entry of this Amendment is proper because it does <u>not</u> raise any new issues requiring

further search by the Examiner, narrows the issues on appeal, and is believed to place the

present application in condition for immediate allowance.

Request for Personal Interview

Applicants respectfully request a personal interview with the Examiner to discuss the

features of the claimed invention and the clear distinctions between the claimed invention

and the alleged combination of references. The Examiner respectfully is requested to contact

the undersigned attorney to arrange for such an interview at a time which is convenient for

the Examiner.

Claims 1-31 are all the claims presently pending in the application. Claims 1, 11, 12,

and 14-18, and 21 are independent. <u>No</u> claim amendments have been made.

Applicants gratefully acknowledge that **independent claims 11, 14, 16, and 17 are**

<u>allowed</u>. However, for the reasons set forth below, Applicants respectfully submit that all of

the claims (i.e., claims 1-31) are patentable over the cited references.

Claims 1-10, 12, 13, 15, and 18-31 stand rejected under 35 U.S.C. § 103(a) as

allegedly being unpatentable over Parulski, et al. (U.S. Patent No. 6,573,927) in view of Ito,

et al. (U.S. Patent No. 6,453,071).

This rejection is respectfully traversed in the following discussion.

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I.   THE CLAIMED INVENTION

The claimed invention is directed to a print designating method and apparatus, and a printing method and apparatus, which may be applied to a digital camera.

In an illustrative, non-limiting embodiment of the present invention as defined by claim 1, a print designating method includes <u>storing, in a print designation file in a recording medium in which a file including image data is stored, print designating information</u> to designate an image to be printed stored in the recording medium. The print designating information includes file specifying information for specifying a subject file including the image to be printed and file type identifying information for identifying whether the subject file includes a moving image file or a still image file. If the subject file includes a moving image file, the print designating information further includes scene specifying information for specifying a subject scene to be printed in the moving image file.

Other exemplary embodiments of the present invention as defined by independent claims 11, 12, and 14-17 also recite similar features.

In another exemplary embodiment of the present invention as defined by claim 18, a print designating device includes means for obtaining and recording image data, which encodes and stores the image data in a recording medium and means for storing, in a print designation file in the recording medium in which the file including image data is stored, <u>print designating information to designate an image to be printed which is stored in the recording medium without duplicating the image data of the image to be printed.</u>

In another exemplary embodiment of the present invention as defined by claim 21, a print designating method includes storing print designation information in a print designation

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file in a recording medium to designate an image to be printed, wherein the recording

medium includes a file including image data of the image to be printed, and wherein the print

designation information designates the image to be printed without duplicating the image

data of the image to be printed.

In conventional devices, the image data of a still image taken from a moving image is

stored redundantly on the recording medium with the image data of the moving image,

thereby wasting memory capacity of the recording medium on which the image data is

stored.

In the claimed invention, on the other hand, the designation of printing from the still

image file and the moving image file can be achieved using a single print designation file

(e.g., without duplicating the image data of the image to be printed).

That is, by taking out the desired still image scene from the moving image file, the

memory capacity of the memory card can be used efficiently since a duplicate still image

data does not have to be prepared. Thus, the claimed invention provides a method and device

for printing a specific scene of a moving image without redundantly storing (i.e.,

duplicating), on the recording medium, the image data of the image to be printed, thereby

avoiding wasting of the memory capacity of the recording medium (e.g., see Figure 2, page

3, lines 17-23, and page 21, lines 18-22).

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II.   THE PRIOR ART REJECTION

Claims 1-10, 12, 13, 15, and 18-31 stand rejected under 35 U.S.C. § 103(a) as

allegedly being unpatentable over Parulski in view of Ito. Applicants respectfully traverse

this rejection.

Applicants incorporate herein by reference in its entirety the Amendment under 37

C.F.R. § 1.111 filed on December 31, 2004, for the Examiner's convenience.

A.   In the "Response to Arguments" section of the Office Action, the Examiner

alleges that, with respect to *"Applicants' argument that the references fail to teach or suggest*

"avoiding wasting of the memory capacity of the recording medium" and "without

redundantly storing (i.e., duplicating) on the recording medium",... the Examiner cannot

locate such limitations in any pending independent claims" (see Office Action at pages 5-6,

bridging paragraph; emphasis Applicants').

Contrary to the Examiner's position, however, Applicants respectfully submit that

such features are recited at least in independent claims 18 and 21, and also in dependent

claims 19, 20, and 22-31.

Since no support for such novel features has been shown in the cited references (and

indeed, since the cited references clearly do not disclose or suggest these features),

Applicants submit that **independent claims 18 and 21, and dependent claims 19, 20, and**

22-31 clearly are in condition for immediate allowance. Therefore, Applicants

respectfully request entry of the same.

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Also, in rejecting claims 18-31, the Examiner states that "*claims 18-31 recite*

limitations that are similar and in the same scope of invention as to those in claims 1-10

above; therefore, claims 18-31 are rejected for the same rejection rationale/basis as

described in claims 1-10" (see Office Action at page 4, last paragraph).

Contrary to the Examiner's position, however, claims 18-31 clearly define more

clearly and particularly the features of the invention, and thus, clearly define different scope

than claims 1-10. Indeed, the Examiner's own statements that claims 1-10 do not recite

"*avoiding wasting of the memory capacity of the recording medium*" and "*without*

redundantly storing (i.e., duplicating) on the recording medium" (which features undeniably

are recited in independent claims 18 and 21 and dependent claims 19, 20, and 22-31), clearly

demonstrates that claims 18-31 recite different subject matter than claims 1-10.

Thus, Applicants submit that independent claims 18 and 21, and dependent claims 19,

20, and 22-31 clearly should be allowable over the cited references, since the Parulski and

Ito, either individually or in combination, do not disclose or suggest at least these features of

the claimed invention, nor has the Examiner established how the cited references teach or

suggest these features.

Alternatively, if the Examiner deems that the features of independent claims 18 and

21, and dependent claims 19, 20, and 22-31 have not properly been considered in order to

determine the patentability of these claims, then Applicants request that the Examiner issue a

new Office Action which properly considers and establishes how the cited references

disclose or suggest all of the features of independent claims 18 and 21, and dependent claims

19, 20, and 22-31 (and which properly resets the time period for reply).

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Applicants note that the Examiner must consider <u>all</u> of Applicants rebuttal arguments

(e.g., see M.P.E.P. § 2144.08, *citing* <u>In re Soni</u>, 54 F.3d 746, 750 34 USPQ2d 1684, 1687

(Fed. Cir. 1995), including those with respect to the failure of the references to teach or

suggest the features recited in independent claims 18 and 21, and dependent claims 19, 20,

and 22-31.

Applicants further note that, where the Applicant traverses any rejection, the

Examiner should, if he or she repeats the rejection, take note the of Applicant's argument and

answer the substance of it (see M.P.E.P. § 707.07(f)).

In this case, Applicants note that the Examiner has <u>not</u> answered the substance of

Applicants' arguments with respect to the failure of the cited references to disclose or suggest

at least *"means for storing, in a print designation file in the recording medium in which the*

file including image data is stored, print designating information to designate an image to be

printed which is stored in the recording medium <u>without duplicating the image data</u> of the

image to be printed" as defined by the specification and recited in independent claim 18

(emphasis added).

Also, the Examiner has <u>not</u> established how the cited references disclose or suggest

that *"said print designation information designates the image to be printed <u>without</u>*

<u>duplicating</u> said image data of the image to be printed" as recited in independent claim 21

(emphasis added).

Somewhat similarly, the cited references also do <u>not</u> disclose or suggest that *"the print*

designating information further includes scene specifying information for specifying a

subject scene to be printed in the moving image file <u>without duplicating</u> image data of the

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subject scene to be printed", as recited in claim 23 (emphasis added), that "*said print designating information is stored in the print designation file in the recording medium without duplicating image data of the image to be printed*", as recited in claim 24 (emphasis added), that "*the print designation file preparing device stores the print designating information in the print designation file in the recording medium without duplicating image data of the image to be printed*" as recited in claim 25 (emphasis added), that "*said print designating information is stored in the print designation file in the recording medium without duplicating image data of the image to be printed and thereby minimizing waste of a memory capacity of the recording medium*" as recited in claim 26 (emphasis added), that "*the print designation file preparing device stores the print designating information in the print designation file in the recording medium without duplicating image data of the image to be printed and thereby minimizing waste of a memory capacity of the recording medium*" as recited in claim 27 (emphasis added), that "*said recording medium includes only a single copy of image data of the image to be printed*" as recited in claims 28 and 29 (emphasis added), that "*said print designating information is stored in the print designation file in the recording medium without redundantly storing image data of the image to be printed*" as recited in claim 30 (emphasis added), or that "*the print designation file preparing device stores the print designating information in the print designation file in the recording medium without redundantly storing image data of the image to be printed*" as recited in claim 31 (emphasis added).

Thus, if the Examiner deems that the features of independent claims 18 and 21, and dependent claims 19, 20, and 22-31 have not properly been considered in order to determine

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the patentability of these claims, then the Examiner should issue a new Office Action which

(1) properly responds to applicants' positions set forth in the Amendment under 37 C.F.R. §

1.111 filed on October 22, 2004, (2) properly considers and establishes how the cited

references disclose or suggest all of the features of <u>independent</u> claims 18 and 21, <u>and</u>

<u>dependent</u> claims 19, 20, and 22-31, and (3) which properly resets the time period for reply.

      B.   In the "Response to Arguments" section, the Examiner also states that *"the*

originally filed specification as shown in figure 8, step S342 and S344 show before printing

any selected scene from a moving image file, such scene is extracted <u>and stored in memory</u>

<u>device</u>; therefore, it <u>duplicates a scene and stored in memory device before printing</u>, which

<u>contradicts</u> the Applicants' arguments" (see Office Action at page 6, first full paragraph;

emphasis added). Applicants respectfully disagree.

     First, Applicants note that the claims must be read in light of the specification.

However, limitations or features from the specification cannot improperly be read or

imported into the claims.

     Second, Applicants submit that the Examiner is misunderstanding the illustrative

features of the invention which exemplarily are illustrated in Figures 7 and 8 of the present

application.

     For example, Figures 7 and 8 exemplarily illustrate a procedure for an automatic

printing apparatus (e.g., 210, as illustrated in Figure 6), according to an exemplary aspect of

the claimed invention (e.g., see specification at page 17, line 1, to page 19, line 28).

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As mentioned above, the claimed invention efficiently uses the *memory capacity of the memory card* (i.e., *the recording medium*) by including a print designation file that designates printing of an image from the still image file and the moving image file, without duplicating or redundantly storing the image data *on the recording medium* (e.g., see claims 18-27, 30, and 31) (i.e., the *recording medium* includes <u>only a single copy</u> of image data of the image to be printed; e.g., see claims 28 and 29). Thus, by designating the desired still image scene from the moving image file, a duplicate still image data does <u>not</u> have to be prepared, and the claimed invention avoids wasting of the memory capacity *of the recording medium* (e.g., see Figure 2, see also specification at page 3, lines 17-23, and page 21, lines 18-22).

Figures 7 and 8 clearly illustrate that that the exemplary method includes a print designation file (e.g., see S304) which is *stored on a memory card* (e.g., see S302; see also memory card 32 in Figure 6) and which permits automatic printing of the image data *stored on a memory card* by a printing apparatus (e.g., 210, for example, a printer).

That is, the claimed invention provides efficient use of the memory capacity *of the memory card*, <u>not</u> the printing apparatus (e.g., see specification at page 17, line 1, to page 19, line 28).

As exemplarily illustrated in Figure 8, the printing apparatus (e.g., 210) takes the image to be printed *out of the memory card* (e.g., 32) as JPEG data if the image is a still image (e.g., see S324 and S340). The printing apparatus 210 (i.e., <u>not</u> the memory card) then expands the JPEG data of the still image and stores it in frame memory *of the printing apparatus 210* for printing (e.g., see S344, S346, S348, S350, and S352).

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Alternatively, the printing apparatus (e.g., 210) takes the image to be printed *out of*

the memory card (e.g., 32) as a chunk of JPEG data from the moving image file (e.g., a frame

of the moving image file designated by the print designation file, see S330). The printing

apparatus 210 (i.e., not the memory card) then expands the chunk of JPEG data of the frame

of the moving image file and stores it in frame memory *of the printing apparatus 210* for

printing (e.g., see S344, S346, S348, S350, and S352).

In other words, the Examiner is confusing storing or duplicating the image file by, for

example, *a printing apparatus 210, a personal computer*, etc., with not duplicating the image

file *on the memory card* (e.g., see specification at page 20, lines 1-6).

Thus, the Examiner has misconstrued steps S342 and S344 of Figure 8 as

contradicting Applicants' arguments regarding the novel features of the claimed invention.

Applicants submit that the Examiner's misunderstanding of the invention appears to form the

basis for maintaining the rejection of the claims based on Parulski and Ito, as explained in

more detail below.

Turning to the language of the claims, independent claim 1 recites, for example, a

print designating method, including:

> *storing, in a print designation file in a recording medium* in
> *which a file including image data is stored, print designating*
> *information to designate an image to be printed which is stored in the*
> *recording medium,*
>   *wherein the print designating information includes:*
>   *file specifying information for specifying a subject file*
> *including the image to be printed; and*
>   *file type identifying information for identifying whether*
> *the subject file comprises a moving image file or a still image file,*
>   *wherein if the subject file comprises the moving image file, the*
> *print designating information further includes scene specifying*

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information for specifying a subject scene to be printed in the moving image file (emphasis added).

Thus, exemplary steps S342 and S344 of Figure 8 clearly illustrate the steps taken *by the printing apparatus* to store the image data after the image data is extracted from the recording medium (which does not duplicate the image data, thereby efficiently using memory capacity of the recording medium). Accordingly, the Examiner has misunderstood the features of the claims and has improperly read or imported S342 and S344 of Figure 8 into the claims.

C.   Turning to the Examiner's comments regarding Parulski and Ito, in the "Response to Arguments", the Examiner takes the position that there is motivation for combining the references in the manner alleged.

Particularly, the Examiner asserts that "*Parulski explicitly teaches a motivation for creating a print designation file (i.e., print order utilization file as shown in Appendix I, for example, the proper number of each selected image is then automatically printed without further user intervention (col. 6, lines 19-26) and to provide the utilization information for multiple images in a single utilization file without having to duplicate each image for each print order ((col. 6, lines 27-30) which is equivalent to application's motivation)*" (see Office Action at page 5, lines 11-16).

However, Applicants respectfully submit that it would not have been obvious to combine Parulski and Ito. Therefore, Applicants traverse this rejection.

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First, Applicants respectfully submit that merely including a print order utilization file

to designate the *"still images"* in still image files (<u>not</u> still images in a moving image file) to

be printed without any additional user intervention (e.g., see Parulski at Abstract) clearly is

<u>not</u> comparable to designating *"scene specifying information for specifying a subject scene to*

be printed <u>in the moving image file</u>", as recited, for example, in independent claim 1

(emphasis added).

In fact, column 6, lines 27-30 of Parulski merely states that "[i]nstead of providing the

utilization information for multiple images <u>in a single utilization file</u>, other embodiments are

possible. For example, the camera <u>may create three utilization files</u>, one containing the

information need to electronic albuming, and a third containing e-mail order information"

(see Parulski at column 6, lines 27-33; emphasis added). Parulski does <u>not</u> disclose or

suggest, however, saving memory capacity for printing still images from moving image files.

Indeed, the Examiner acknowledges that *"Parulski teaches the same features (i.e.,*

print designation file for still images) <u>except for moving image data</u>" (e.g., see Office Action

at page 5, lines 19-21; emphasis added).

Second, the Examiner asserts that Ito makes up for the deficiencies of Parulski (see

Office Action at page 5, lines 21-27). However, Applicants submit that it would <u>not</u> have

been obvious to combine Parulski and Ito, for several reasons. Moreover, even assuming

arguendo that it would be obvious (or possible) to combine Parulski and Ito as alleged,

Applicants submit that Ito clearly does <u>not</u> make up for the deficiencies of Parulski.

For example, as mentioned above, Parulski discloses a technique which stores a

"utilization file", available in utilizing a print service for data of still image, into a removable

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memory card along with image data (data of still image). However, Parulski does <u>not</u>

disclose <u>printing a part of a moving image.</u>

On the other hand, Ito discloses a technique in which a desired frame in a moving

image is designated and printed.

Although the Examiner asserts that it would have been obvious to combine Parulski

with Ito to arrive at the claimed invention, the technique described by Ito is for designating a

desired frame (i.e., a <u>frame constituting a moving image</u>) <u>during reproduction of the moving</u>

<u>image,</u> which clearly is distinct from specifying a subject scene to be printed according to the

claimed invention.

That is, Ito discloses a means for printing a scene in a moving image currently being

reproduced while reproducing the moving image. In Ito, a processing which sequentially

reproduces data of the moving image is required, and a desired frame is designated in the

moving image being reproduced.

In stark contrast, the claimed invention stores information (e.g., scene specifying

information) to specify a subject scene (e.g., a frame) to be printed in a moving image, into a

print designation file, thereby significantly improving the convenience of printing of a frame

in the moving image stored in a recording medium.

Moreover, the claimed invention provides an advantage that printing from a recording

medium in which both moving images and still images are recorded can be performed.

The technique of Ito clearly <u>cannot be applied to print designation on a static</u>

<u>recording medium</u> as in the claimed invention, for example, because the recording

medium does <u>not</u> have a time-axis.

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Moreover, according to Ito, a data moving image is transmitted by synchronous

transmission (i.e., isochronous transmission). Also, in an unoccupied time period (i.e., a non

data-communication period) of the communication cycle, the data of an image (i.e., a still

image) to be printed is transmitted by Asynchronous transmission in parallel with

Isochronous transmission. This means that a still image to be printed is redundantly

transmitted, separately from the original moving image.

Therefore, even assuming *arguendo* that the technique of Ito *could be applied* to a

static recording medium (which Applicants submit *could not be applied*), a still image to be

printed (i.e., a frame of an image captured from a moving image) is redundantly recorded.

Thus, the resulting combination clearly would be distinct from the claimed invention (i.e.,

any combination of Parulski and Ito clearly would not arrive at the features of the claimed

invention).

That is, even assuming *arguendo* that it would have been obvious to combine Parulski

and Ito, Applicants respectfully reiterate that there are still elements of the claimed invention

which clearly are not disclosed or suggested by Parulski or Ito, either alone or in

combination, and therefore, respectfully traverse this rejection.

As mentioned above, the Examiner acknowledges that Parulski does not explicitly

disclose that, if the subject file comprises a moving image file, the print designating

information further includes scene specifying information for specifying a subject scene to be

printed in the moving image file.

However, the Examiner asserts that Ito makes up for the deficiencies of Parulski by

teaching "*a digital camera for recording still and moving image data. Ito's motivation of*

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doing so is taught on col. 24, lines 53-58 "the communication system of the first embodiment

can not only select still image information contained in moving image information without

using an editing apparatus such as PC, but also print the still image information with each

and quickly "" (see Office Action at page 5, lines 21-27).

Applicants respectfully disagree with the Examiner's position for several reasons.

For example, independent claim 1 recites, *inter alia,* a print designating method,

including:

> storing, in a print designation file in a recording medium in
> which a file including image data is stored, print designating
> information to designate an image to be printed which is stored
> in the recording medium,
> wherein the print designating information includes:
> file specifying information for specifying a subject file
> including the image to be printed; and
> file type identifying information for identifying whether the
> subject file comprises a moving image file or a still image file,
> and
> wherein if the subject file comprises the moving image file,
> the print designating information further includes scene
> specifying information for specifying a subject scene to be
> printed in the moving image file (emphasis added).

According to the claimed invention, because the print designating information

includes scene specifying information for specifying a subject scene (e.g., a still image) to be

printed in the moving image file, it is possible to designate the printing of either the still

image file or the moving image file using a single print designation file without duplicating

the image data of the image to be printed. That is, by taking out the desired still image scene

from the moving image file, the memory capacity of the memory card can be used efficiently

since a duplicate still image data does not have to be prepared.

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Thus, the claimed invention provides a method and device for printing a specific

scene of a moving image without redundantly storing (i.e., duplicating), on the recording

medium, the image data of the image to be printed, thereby avoiding wasting of the memory

capacity of the recording medium (e.g., see Figure 2, page 3, lines 17-23, and page 21, lines

18-22).

In comparison, Parulski merely discloses an electronic still camera for capturing still

images and storing the images on a recording medium. The still camera includes a user

interface for displaying and scrolling through a plurality of still images stored on the memory

card, and for selecting particular still images to be printed. The camera has a processor that

stores a print utilization file on the removable memory card separate from the still image files

(e.g., see Parulski at column 3, lines 25-62; see also column 9, lines 25-51).

In contrast to Parulski (and the claimed invention), Ito relates to data communication

techniques using communication control buses capable of dealing with mixed control and

data signals (e.g., see Ito at column 1, lines 8-14).

Particularly, Ito discloses data communication techniques for improving

communication efficiency and reducing a capacity *of a memory used for communications*

(e.g., see Ito at column 2, lines 44-50). That is, Ito discloses reducing the amount of still

image data and moving image data being transferred between apparatuses by using

various compression encoding techniques, such as JPEG and MPEG (e.g., see Ito at column

1, lines 30-37).

For example, Ito discloses using a communication scheme that is isochronous with a

predetermined communication cycle for transmitting moving images and a communication

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scheme that is isochronous or asynchronous with the communication cycle for transmitting

still images (e.g., see Ito at column 3, line 65, to column 4, line 5). Thus, Ito is concerned

with the communication scheme between the camera and a PC, not with efficiently using the

memory capacity of the recording medium.

Thus, Ito is concerned with communication schemes for transmitting still image data

and moving image data between apparatuses. Therefore, Ito (1) is not in the same field of

endeavor of the claimed invention (e.g., print designation methods and devices) and (2) is not

reasonably pertinent to the particular problem with which the inventor was concerned (e.g.,

efficiently using memory capacity of a recording medium or memory card which stores

image data of images to be printed).

Applicants submit that the ordinarily skilled artisan would not have looked to the

teachings of Ito, which relate to a communication scheme that is isochronous with a

predetermined communication cycle for transmitting moving images and a communication

scheme that is isochronous or asynchronous with the communication cycle for transmitting

still images (e.g., see Ito at column 3, line 65, to column 4, line 5), to solve the problems of

efficiently using memory capacity of a recording medium (e.g., a memory card for a camera).

Therefore, Ito clearly is not analogous prior art to the claimed invention and should

not be relied upon to reject the claims of the present application.

Moreover, Applicants respectfully submit that the Examiner's reliance on column 24,

lines 53-58 of Ito has nothing to do with efficiently using memory capacity of the recording

medium, as claimed.

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Contrary to the claimed invention, Ito merely discloses that *the camera* can be used to select still images from the moving images and transmit <u>both</u> the moving images <u>and</u> the still images (i.e., the moving images <u>and</u> the still images are stored <u>separately</u>), <u>not</u> that print designating information is used <u>to specify a subject scene to be printed in the moving image file</u>, as claimed.

Figure 24 of Ito specifically shows <u>two channels</u> (i.e., channel **a** and channel **b**), each of which is used to transfer either the moving images or the still images, respectively, to the PC (e.g., see Ito at column 25, line 66, to column 26, line 3). That is, channel **a** is used to transfer the moving image data, while channel **b** is used to transfer the still image data. The user can then view both the moving image and the still image on the monitor of the PC to confirm the still image to be printed (e.g., see column 26, lines 34-60).

Ito does <u>not</u>, however, disclose or suggest saving memory capacity *on the storage medium* (e.g., a *memory card*) such that a still image can be printed from a moving image stored on the storage medium (e.g., a memory card).

In fact, Applicants respectfully submit that "*selecting and extracting a specific scene from a moving file to be printed*", as allegedly taught by Ito, <u>clearly is different than</u> disclosing <u>print designating information</u> that includes scene specifying information for specifying a subject scene to be printed in the moving image file, according to the claimed invention.

Thus, Applicants submit that Ito clearly does <u>not</u> make up for the deficiencies of Parulski. That is, contrary to the Examiner's position, Applicants respectfully submit that Ito does <u>not</u> disclose or suggest this feature of the claimed invention, and therefore, even

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assuming *arguendo* that it would have been obvious to combine these references, Ito would

not have made up for the deficiencies of Parulski.

For the foregoing reasons, Applicants submit that Parulski and Ito, either individually

or in combination, do not disclose or suggest all of the features of the claimed invention, as

recited, for example, in independent claim 1. Any combination of Parulski and Ito clearly

would not teach or suggest taking out the desired still image scene from the moving image

file, such that the memory capacity of the memory card can be used efficiently (e.g., a

duplicate still image data does not have to be prepared).

For the foregoing reasons, Applicants submit that Parulski and Ito clearly would not

have disclosed or suggested all of the features of independent claim 1, and therefore, the

rejection of this claim should be withdrawn.

Other exemplary embodiments of the present invention, as defined by independent

claims 12, 15, 18, and 21, recite somewhat similar features, and therefore, also should be

patentable over the cited references for somewhat similar reasons, as well as for the features

recited therein.

For the foregoing reasons, Applicants respectfully submit that the prior art of record

fails to disclose storing a print designation file (or a device which stores such a print

designation file) in a recording medium in which a file including image data is stored that

designates a still image to be printed which is stored in a moving image file stored in the

recording medium, as claimed in independent claims 1, 12, 15, 18, and 21, or for that matter

even contemplate (or teach or suggest) reducing the wasting of memory capacity in the

storage medium, according to one of the exemplary aspects of the claimed invention.

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Moreover, dependent claims 2-10, 13, 19, 20, and 22-31 also are patentable over

Parulski and Ito, either alone or in combination, by virtue of their respective dependencies, as

well as for the additional features recited therein.

Thus, Applicants respectfully request that the Examiner reconsider and withdraw this

rejection and permit these claims to pass to immediate allowance.

III.   CONCLUSION

In view of the foregoing, Applicants submit that claims 1-31, all the claims presently

pending in the application, are patentably distinct over the prior art of record and are in

condition for allowance. The Examiner is respectfully requested to pass the above

application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance,

the Examiner is requested to contact the undersigned at the local telephone number listed

below to discuss any other changes deemed necessary in a _telephonic or personal interview._
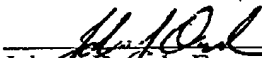
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit

any overpayment in fees to Attorney's Deposit Account No. 50-0481.

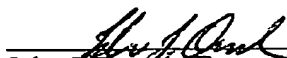Respectfully Submitted,

Date: _August 17, 2005_

John J. Dresch, Esq.
Registration No. 46,672

Sean M. McGinn, Esq.
Registration No. 34,386

McGinn & Gibb, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 the enclosed Response

under 37 C.F.R. § 1.116 to Examiner Thierry L. Pham, Art Unit 2624, on August 17, 2005.

John J. Dresch, Esq.
Registration No. 46,672
Sean M. McGinn, Esq.
Registration No. 34,386